

JAN-23-2004 16:58

PERMAN & GREEN, LLP

RECEIVE
CENTRAL FAX CENTER

P.01

#20
cde

JAN 23 2004

OFFICIAL

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED

APPLICANT(s): Seymour

FEB 10 2004

SERIAL NO.: 08/987,995

ART UNIT: 2686

DIRECTOR OFFICE

FILING DATE: 12/10/1997

EXAMINER: Mehrpoosh Naghmeh TECHNOLOGY CENTER 2000

TITLE: PORTABLE ELECTRONIC APPARATUS

ATTORNEY

DOCKET NO.: 200-007711-US (PAR)

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PERMAN & GREEN, LLP

FACSIMILE MESSAGE

TOTAL OF 4 PAGES

ORIGINAL IS BEING MAILED

OUR FAX: 203 255-5170

PETITION UNDER 37 C.F.R. §1.181

I. INTRODUCTION

Applicant respectfully petitions for withdrawal of the Office Action mailed November 20, 2003 since it was issued without authorization of the Commissioner to reopen prosecution as required under 37 C.F.R. §1.198. In the event that an appropriate request to reopen prosecution was made by the Examiner and granted by the Commissioner, a new Office Action is respectfully solicited that specifically indicates such request and the authorization, and resets the statutory period for reply.

II. FACTS

A decision on appeal (the "Decision") by the Board of Patent Appeals and Interferences (the "Board") was mailed on March 31, 2003. A new Office Action issued by the Examiner, based on a new search, was mailed November 20, 2003 (Paper No. 19). This

petition is being filed pursuant to 37 C.F.R. §1.181 within two months of the action complained of.

III. DISCUSSION

It is respectfully submitted that this Office Action is inappropriate since prosecution of this application after a decision on appeal has not been reopened in accordance with 37 C.F.R. §1.98. Cases decided by the Board of Patent Appeals and Interferences will not be reopened or reconsidered by the primary Examiner except under the provisions of 37 C.F.R. §1.14 or §1.196, without the written authority of the Commissioner. (37 C.F.R. §1.198). The Office Action of November 20, 2003 is defective, because it does not indicate that authorization to reopen prosecution was requested and granted.

The Decision did not sustain the Examiner's rejection of claims 12 through 19 under 35 U.S.C. §103(a) as being unpatentable over Saji in view of French. This complete reversal of the Examiner's rejection brings the case up for immediate action by the Examiner. (M.P.E.P. §1214.04). However, the "Examiner should never regard such a reversal as a challenge to make a new search to uncover other and better references." (M.P.E.P. §1214.04). Rather, the application is thus returned to the Examiner to carry into effect the decision. (37 C.F.R. §1.197). The Board did not issue any statement that would constitute a new ground of rejection of the claims. Nor did the Board include or allow a remand. (see 37 C.F.R. §1.196).

In order to reopen prosecution, the Examiner is required to submit the matter to the Technology (TC) Director for authorization to reopen prosecution under 37 C.F.R. §1.198 for the purpose of entering the new rejection. (M.P.E.P. §1214).

The Office Action of November 20, 2003 does not indicate that any request was made by the Examiner to reopen prosecution after the Decision. Thus, without authorization to reopen prosecution, the issuance of this Office Action dated November 20, 2003 is improper.

Therefore, Applicant respectfully requests that this Office Action be withdrawn and purged from the file. In the event that authorization was granted to reopen prosecution, a new action should be issued with a reset statutory period for reply.

Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,


Geza G. Ziegler, Jr.
Reg. No. 44,004

23 JANUARY 2004
Date

Perman & Green, LLP
425 Post Road
Fairfield, CT 06824
(203) 259-1800 Ext. 134
Customer No.: 2512

BY FAX
(703) 872-9300

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being transmitted by facsimile to (703) 872-9306 on the date indicated below, addressed to [REDACTED], Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450

Date: 23 JAN 2004

Signature: Jeff Ziegler
Person Making Deposit